

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-10 are rejected under 35 USC 102(b) over the U.S. patent to Zagorski.

Claim 1, 11 and 12 are also rejected under 35 USC 102(b) over the patent to Henderson.

Also, the drawings are objected to.

Turning now to the Examiner's grounds for objections to the drawing, it is believed that the drawing do not contain erasures, alterations, overwriting, inter-lineations, etc. as suggested by the Examiner. The drawing has margins which are appropriately sized as required. The lines, numbers and letters are uniformly thick and well defined, etc.

Figure 2 does not show separate views that are not labeled separately and properly. It is allowed in accordance with the drawing requirements of the U.S. Patent and Trademark Office to identify the front view and the side view shown in Figure 2 either by different reference numerals, for example 2a and 2b, or by one reference numeral, for example Figure 2, with the

views of the drawing associated with one another through a bracket, as was properly done.

It is therefore believed that these reasons for the Examiner's objections to the drawing should be considered as not longer tenable and should be withdrawn.

The Examiner further stated that the drawing was objected to because Figures 1 and 2 show separate embodiments viewed from a common position that does not reveal the width in a direction (Y). He further stated that this limitation could not be shown without the addition of new matter.

The Examiner is right in saying that Figures 1 and 2 show different embodiments; however, it has nothing to do with the feature that the width in the direction (Y) is smaller than the dimensions in the other directions. As for the Examiner's statement related to the limitation that the width dimension in the direction (Y) is smaller than the dimension in the axial direction and the dimension in the radial direction, the Examiner's attention is respectfully directed to the specification, and in particular to the paragraph in lines 12-23 on page 8. It is specifically stated there that the connecting element (15) shown in Figure 2 is thin, i.e. the dimension in the (Y) direction is small in comparison to the dimensions in the (X) direction and the (Z) direction.

It is well known that the specification constitutes a part of the original disclosure and therefore the feature that the dimension in the (Y) direction is small in comparison to the dimensions in the (X) direction and (Z) direction does not constitute new matter. It is true that this feature was not illustrated in the original drawings; however, it is acceptable to correct the drawings based on the disclosure in the specification, and this is what was suggested in corrected Figure 2, which now shows the width in the direction (Y) that is small in comparison to the dimensions in the (X) direction and (Z) direction.

It is therefore believed that the Examiner's objections to the drawing based on his opinion that the correction to the drawing raised the issue of new matter, should be also be considered as not tenable and should be withdrawn.

Turning now to the Examiner's grounds for the rejection of the claims over the art, it is respectfully submitted that the Examiner's suggestion to define the present invention as an assembly including the motor, the transmission, and the connecting device has been gratefully appreciated. In connection with the Examiner's suggestion, the original claims have been cancelled and replaced with a new set of claims including Claim 14, the broadest claim on file, and Claims 15-25 which depend on it. The claims have been drafted to define the assembly as suggested.

The Examiner rejected the claims over the U.S. patent to Zagorski and provided an illustration showing how in his opinion this reference disclosed the new features of the present invention. Applicants have to respectfully disagree with this position for the following reasons. In the drawing submitted by the Examiner, the dimension (A) corresponds to the width dimension of the connecting element of the present invention in the direction (Y), the dimension (B) corresponds to the radial dimension in the direction (Z) perpendicular to the axis of the motor shaft, and the dimension (C) corresponds to the axial dimension in the direction (X) of the axis of the motor shaft. As can be seen from the Examiner's drawing and from the patent to Zagorski, the width dimension (A) of the illustrated connecting element, contrary to the applicant's invention, is greater than its axial dimension (C) and radial dimension (B).

It is therefore believed to be clear that this reference does not teach the new features of the present invention as defined in Claim 14, and moreover discloses the construction which is opposite to the new features of the applicant's invention.

Turning now to the patent to Henderson, the Examiner considered a plastic ring (76, 78) as representing at least one connecting element. While the connecting element (76, 78) does not connect the motor housing to the

transmission housing, nevertheless it is advisable to compare the ring (76) and/or (78) to the connecting element of the present invention.

In Figure 6 of the patent to Henderson, the axial dimension is a dimension in a direction of the axis of the ring, the radial dimension in a direction perpendicular to the axis is a dimension in the vertical direction in the drawing of Figure 6 (the diameter of the ring), and the width dimension in a direction perpendicular to the axial and radial dimensions is a dimension corresponding to the diameter perpendicular to the plane of the drawing of Figure 6. The thusly determined width dimension of the ring (76) or (78) of the device disclosed in the patent to Henderson is equal to the radial dimension in the direction perpendicular to the axis (the vertical direction), and is significantly greater than the axial dimension in the direction of the axis of the ring (76, 78).

Thus, the new features of the present invention as now defined in Claim 14 are not disclosed in this reference as well.

Definitely, the connecting elements disclosed in the references do not have the width dimension which is smaller than the axial dimension in a direction of the axis of the motor shaft and the radial dimension in a direction perpendicular to the axis of the motor shaft, so that the connecting element elastically deforms with a rotation of said motor housing around the axis and in

relation to said transmission housing, and vibrations generated by a rotary motion of said motor are at least substantially decoupled.

The original claims were rejected over the above-discussed references as being anticipated. In connection with this, it is believed to be advisable to cite the decision *In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patents to Zagorski and Henderson disclose the devices which do not include each and every element of the present invention as now defined in Claim 14, and therefore the anticipation rejection of the original claims should be considered as no longer tenable with respect to Claim 14 and should be withdrawn.

The present invention also cannot be considered as obvious from the references. As explained hereinabove, the references do not contain any hint, suggestion, or motivation for the above-analyzed new features of the present invention, and instead teach a completely opposite approach. In order to arrive at applicant's invention from the teachings of the references taken singly or in combination with one another, the devices disclosed in the references have to

be fundamentally modified, and in particular redesigned to operate in a completely opposite manner. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Finally, as explained hereinabove, the present invention provides for the highly advantageous results which cannot be accomplished by the devices disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above it is believed to be clear that the present invention as defined in Claim 14 also cannot be considered as obvious from the references taken singly or in combination with one another.

Claim 14 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 14, they share its allowable features, and they should be allowed as well.


Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should



the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicant(s)  
Reg. No. 27233  
103 East Neck Road  
Huntington, New York 11743  
631-549-4700